

REMARKS/ARGUMENTS

Claims 2-6, 12-28 and 30 -32 are currently being examined in this application, with claim 29 being withdrawn. Claims 1 and 7-11 have been cancelled, claims 2-6 and 12-28 have been amended and claims 30-32 have been added. Applicants respectfully request entry of the above amendments and submit that the above amendments do not constitute new matter.

At the outset, as per the Requirement set forth at paragraph 4 of the Official Action, Applicants hereby confirm their previous telephonic election of the invention of Group I namely, Claims 1-28, without traverse.

In response to paragraph 7 of the Official Action, applicants attach hereto a Declaration duly executed by the inventors and properly identifying applicants' entitlement to the benefit of PCT/FR99/03062 under the provisions of 35 U.S.C. §120.

Further to Paragraph 8, of the Office Action, Applicants have amended the first sentence of the application to reference the priority applications. The added paragraph clarifies that the present application is indeed a continuation of PCT/FR99/03062. Applicants note that they now fully comply with 35 U.S.C. §120.

Further to Paragraph 10, of the Office Action, Applicants have provided an Abstract.

Claim Objections

The Office Action states that claims 4-28 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must not depend from another multiple dependent claim. Accordingly, Applicants have amended claims 4-28 so that multiple dependent claims no longer depend from other multiple dependent claims.

Applicants respectfully request that the objections under 37 CFR 1.75(c) be removed.

Rejections under 35 U.S.C. § 102

The Office Action states that claims 1-3 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Fritsch et al., “Cloning and characterization of a 77-kDa oestrogen receptor isolated from a human breast cancer cell line,” British J. of Cancer, Vol. 75(1):17-27, 1997 (“Fritsch et al.”); U.S. Patent No. 5,360,714, issued to Seeger (“Seeger”); and U.S. Patent No. 5,767,233, issued to Zhang et al. (“Zhang et al.”).

Generally, the claimed invention is directed toward a method of screening a substance able to modify the known function of one or more proteins comprising the steps of (a) producing *in vitro* said proteins (b) measuring and/or detecting variation of the known function in the presence and in the absence of the substance which is screened. “Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” (*Electro Med. Sys. S.A. v. Cooper Life Sciences*, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994)). Applicants provide further explanation as to why the new and amended claims even further define the invention over the applied prior art.

Applicants respectfully submit that the present invention, as recited in the claims, distinguishes over Fritsch et al., Seeger, and Zhang et al. The term, “substance”, as recited in the claims and described in the specification, is a molecule that is able to modify the activity of the detected function through the corresponding presence or absence of the proteins. As recited in new claim 30, the substance is “able to modify a known function.” In contrast, the substances disclosed by Fritsch et al. (an oestrogen receptor), Seeger (a substrate of DNA polymerase), and Zhang et al. (a substrate of the protease), are not able to modify the detected function. Indeed, none of the substances defined by the references are screened for their ability to modify the detected function.

For at least the foregoing reasons, the present invention distinguishes over Fritsch et al., Seeger, and Zhang et al. Accordingly, Applicants respectfully request removal of the rejections against the now pending claims under 35 U.S.C. § 102(b).

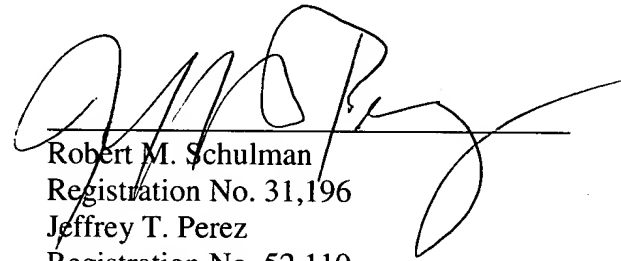
CONCLUSION

Applicants respectfully request entrance of the above specification and claim amendments. In view of the above amendments and remarks, early notification of a favorable consideration is respectfully requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0206.

Respectfully submitted,

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